REMARKS

Claims 1-70 are pending in the application.

Claims 1-70 have been rejected.

No claims have been allowed.

Reconsideration of the claims is respectfully requested.

I. REJECTIONS UNDER 35 U.S.C. § 103(a).

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,708,778 to *Monot* in view of United States Patent No. 6,012,088 to *Li et al.* (hereafter "*Li*"). Claims 1–6, 15–20, 30–34, 43–48, and 57-62 were rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,838,907 to *Hansen* in view of *Li*. Claims 7–14, 21–28, 35–42, 49–56 and 63-70 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hansen* in view of *Li* and further in view of United States Patent No. 6,286,038 to *Reichmeyer et al.* (hereafter "*Reichmeyer*"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness

is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

A. Rejection of Claim 1.

The Applicant notes that Claim 1 recites a step of determining configuration attributes for operably connecting the first network device to the subnet based on configuration information for the subnet detected by the first network device. Such a feature is not shown or suggested by the

Monot reference or by the *Li* reference. *Monot* teaches a method of autoconfiguration of a computer terminal within a network in which the parameters for the terminal are determined by iteratively probing the network's carrier equipment starting with an initial set of parameters and utilizing any probe responses until the parameter set is narrowed to a set of correct parameters. The probe, however, does not involve detecting configuration information for the network, only the parameters which should be used by the terminal to operate with the network.

The *Monot* method uses one probe (or set of probes) for each parameter (*Monot*, Col. 2, Lines 12-13). The *Monot* method uses a computer to "iteratively restrict" the parameter values. "This computer implemented method thus uses the series of probes and answers to iteratively restrict the current set of potential values for a parameter. This restriction occurs until a correct value of the parameter can be determined from the current set of potential values." (*Monot*, Col.2, Lines 30-34). The "iterative probing technique" of *Monot* sends out and receives multiple messages for each parameter value that the *Monot* terminal configures.

The "automatic configuration program" of *Monot* performs the "iterative probing technique" of the *Monot* method. (*Monot*, Col. 2, Lines 40-45). The meaning of the term "automatic configuration" as used by *Monot* is limited to the *Monot* "iterative probing technique." Therefore, *Monot* does not disclose, teach or suggest the "autoconfiguration module" of the Applicant's invention. This is because the "automatic configuration program"of *Monot* does not configure the *Monot* terminal with "configuration attributes based on configuration information for the subnet" detected by the *Monot* terminal.

The Office Action concedes that *Monot* fails to disclose configuration attributes for operably connecting the first network device to the subnet based on configuration information for the subnet detected by the first network device. (March 6, 2003 Office Action, Page 2, Paragraph 2). The Office Action apparently takes the position that: (1) the *Li* reference discloses "configuration attributes" of the type described by the Applicants, (2) it would have been obvious to combine the teachings of *Monot* and *Li*, and (3) Claim 1 is obvious in view of the combination of *Monot* and *Li*. The Applicant respectfully traverses these assertions.

The *Li* reference purports to describe a method for automatically configuring an Internet access device. Although *Li* uses the term "automatic configuration" it is clear that the meaning of the term "automatic configuration" as used by *Li* does not describe the "automatic configuration" process that is described and claimed by the Applicant. The *Li* device is able to "automatically connect itself to an appropriate location on the Internet" and to "download configuration information." (*Li*, Col. 9, Lines 15-16). With the exception of certain identification information provided by the user (e.g., a desired domain name) (*Li*, Col.9, Lines 52-53), all of the configuration information to configure the *Li* Internet access device is stored in a database in an Internet Service Provider (ISP). (*Li*, Col.9, Lines 50-59). "The configuration file contains all of the configuration needed by the customer to configure his Internet access device." (Emphasis added) (*Li*, Col. 9, Lines 57-59).

The *Li* Internet access device simply calls up the ISP and downloads the configuration information. This may be clearly seen by referring to FIGURE 11b and FIGURE 12. Step 724

of FIGURE 11b states "Download Configuration Record." Step 726 of FIGURE 11b states "Configure Internet Access Device Using Configuration Record (Figure 12)." FIGURE 12 contains a sequence of configuration steps. Nothing in the *Li* reference discloses, teaches or suggests the concept of having the Internet access device search the network for "configuration attributes" in the manner disclosed by the Applicant.

The Applicant respectfully submits that there exists no teaching, suggestion or motivation in the prior art to combine the teachings of the *Monot* reference and the teachings of the *Li* reference. The *Monot* method performs an "iterative probing technique" and the *Li* method automatically downloads previously stored configuration information from an ISP database. The *Monot* method and the *Li* method arguably teach away from each other. For this reason, the Applicant respectfully submits that the rejection of Claim 1 under 35 U.S.C. §103(a) combining the *Monot* reference and the *Li* reference should be withdrawn.

Accordingly, the Applicant respectfully requests the withdrawal of the §103(a) rejection of Claim 1 in view of *Monot* and *Li*.

B. Rejection of Claims 1-6, 15-20, 30-34, 43-48 and 57-62.

The Applicant notes that independent Claims 1, 15, 29, 43, and 57 each recite the element of determining configuration attributes for operably connecting a first network device to a subnet based on configuration information for the subnet detected by the first network device. Such a feature is not disclosed, taught or suggested by the references cited as the basis for the rejection of

those claims, either taken alone or in combination. On Page 3 of the March 6, 2003 Office Action, the Office Action states that "Hansen teaches a method of configuring a first network device for connection to a communications network subnet having a second network device, the method comprising: determining, with a configuration determination module of the first network device (col.2, lines 39-67), configuration attributes for operably connecting the first network device to the subnet based on configuration information for the subnet detected by the first network device (col.15, lines 5-18). Hansen does not explicitly disclose configuring the first network device, with an auto configuration module." (March 6, 2003 Office Action, Page 3, Paragraph 3).

The Office Action asserts that *Hansen* teaches the use of a configuration determination module of the first network device for determining configuration attributes for operably connecting the first network device to the subnet. To the contrary, *Hansen* describes "a configuration manager for configuring a network device remotely coupled thereto . . ." (Emphasis added) (*Hansen*, Abstract). *Hansen* discloses a network device configuration tool 10 within a computer system 2. (*Hansen*, Col. 4, Lines 65-67). The network device configuration tool 10 is not located within network device 26. The network device configuration tool 10 constructs a configuration file suitable for export from computer 2 to network device 26. Network device configuration tool 10 sends the configuration file (with configuration information) to the remotely located network devices 26. (*Hansen*, Col.5, Lines 22-26). Therefore, *Hansen* does not teach "the use of a configuration determination module of the first network device for determining configuration attributes for operably connecting the first network device to the subnet." *Hansen* does not teach a configuration

determination module within the first network device. *Hansen* also does not teach an autoconfiguration module within the first network device.

Hansen only teaches a guided configuration process employing requests to the network administrator for configuration information. Hansen teaches the use of a configuration guide 18 within computer 2 to collect information necessary to configure the network device by engaging the network administrator in a dialog during which the configuration guide 18 generates a series of graphical user interfaces (GUIs). Each GUI displays a request for information and provides areas in which the requested information may be inputted and buttons for guiding the network administrator through the dialog. (Hansen, Col. 14, Lines (23-29). *Hansen* does not teach or suggest the concept of employing configuration information for a subnet detected by the network device to determine configuration attributes for operably connecting the network device to the subnet.

The Office Action concedes that *Hansen* does not disclose configuring the first network device, with an auto configuration module. (March 6, 2003 Office Action, Page 3, Paragraph 3). The Office Action takes the position that: (1) the *Li* reference discloses an "auto configuration module" of the type described by the Applicants, (2) it would have been obvious to combine the teachings of *Hansen* and *Li*, and (3) claims in question are obvious in view of the combination of *Hansen* and *Li*. The Applicant respectfully traverses these assertions.

Applicant reiterates its assessment of the *Li* reference (as described above). As noted previously, nothing in the *Li* reference discloses, teaches or suggests the concepts of (1) having the Internet access device search the network for "configuration attributes" in the manner disclosed by

the Applicant, or (2) having the Internet access device configure itself with an "autoconfiguration module" in the manner disclosed by the Applicant.

The Applicant respectfully submits that there exists no teaching, suggestion or motivation in the prior art to combine the teachings of the *Hansen* reference and the teachings of the *Li* reference. The *Hansen* method performs a guided configuration process employing requests to the network administrator for configuration information. The *Li* method automatically downloads previously stored configuration information from an ISP database. The *Hansen* method and the *Li* method arguably teach away from each other. For these reasons, the Applicant respectfully submits that the rejection of Claims 1, 15, 29, 43, and 57 (and dependent claims) under 35 U.S.C. §103(a) combining the *Hansen* reference and the *Li* reference should be withdrawn.

C. Rejection of Claims 7-14, 21-28, 35-42, 49-56 and 63-70.

The Applicant respectfully submits that the deficiencies of the *Hansen* reference and the *Li* reference can not be supplied by the *Reichmeyer* reference. *Reichmeyer* does not disclose, teach, or suggest the Applicant's concept of detecting configuration information from a subnet, and determining configuration attributes from the configuration information, and automatically configuring a network device with the configuration attributes.

The *Reichmeyer* reference is similar to the *Hansen* reference in that the *Reichmeyer* method provide remote configuration to a network device. *Reichmeyer* provides "a method of remotely configuring a network device configuration" by generating "configuration information for the

network device at a central configuration server, which is located remotely from the network device on a network." (*Reichmeyer*, Abstract). The *Reichmeyer* device sends configuration information to the network device. Nothing in the *Reichmeyer* reference discloses or even hints at the concept of having (1) the network device search the network for "configuration attributes" in the manner disclosed by the Applicant or (2) having the network device configure itself with an "autoconfiguration module" in the manner disclosed by the Applicant.

Thus, Claims 7-14, 21-28, 35-42, and 63-70 are patentable over the combination of *Reichmeyer* and *Hansen* and *Li*.

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that Claims 1-70 in the Application are in condition for allowance, and respectfully requests an early allowance of Claims 1-70.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ***rmccutcheon@davismunck.com***.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 6/6/2003

Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *rmccutcheon@davismunck.com*